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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,336	02/01/2001	Swinton B. Burkhalter	101	9210

7590   08/08/2006

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EXAMINER
COBANOGLU, DILEK B

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 May 2006*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/14/2004*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the amendment filed 05/15/2006. Claims

1-16 continue pending.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 3-9, and 11-16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Libman (U.S. Patent No.5, 987,434) in view of Gamble et al. (U.S.

Patent No. 6,163,770).

A. Claims 1, 3-9, and 11-16 have not been amended, and they are rejected for

the same reasons set forth in the previous Office Action (Paper number 2-12).

Applicant's arguments with respect to the aforementioned rejection are

addressed below in the section entitled "Response to Argument".

4.   Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Libman (U.S. Patent No.5, 987,434) and Gamble et al. (U.S. Patent No. 6,163,770) as

described above in further view of Sexton et al (U.S. Patent No. 5,752,236).

A. Claims 2 and 10 have not been amended, and they are rejected for the same

reasons set forth in the previous Office Action (Paper number 12-14). Applicant's

arguments with respect to the aforementioned rejection are addressed below in

the section entitled "Response to Argument".

Response to Arguments

5.   Applicant's arguments filed 05/15/2006 have been fully considered but they are

not persuasive. Applicant's arguments will be addressed below in the order in which

they appear.

A. In response to applicant's first argument on page 9, that the Libman reference

fails to show certain features of applicant's invention, it is noted that the features

upon which applicant relies (i.e., disproportional allocation among related

products so as to favor one owner of the related products over another owner)

are not recited in the rejected claim(s). Claim 1 discloses "disproportionately

allocating expenses, benefits and obligations regarding said policies among said

at least two separate but related policies formed from said life insurance product

and said long-term care product". Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

B. In response to Applicant's second argument on page 9, the Libman reference

fails to show certain features of applicant's invention, it is noted that the features

upon which applicant relies (i.e., tentative or brand new insurance product at the

beginning of his process nor of the formation of new products during the practice

of his sales process) are not recited in the rejected claim(s). Claims disclose

"choosing or forming an insurance product, and forming in a data processing

apparatus at least two separate but related insurance policies from said life

insurance product and said long-term care product". Although the claims are

interpreted in light of the specification, limitations from the specification are not

read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057

(Fed. Cir. 1993).

C. In response to Applicant's third argument on page 10, Examiner respectfully

submits that Libman reference discloses "analyzing a variety of plans and

financial products which are calculated to meet the needs of the client, and

applying decision making criteria to select from among those plans and products

the ones most suitable for the client based on the decision making criteria";

therefore analyzing the products which are calculated to meet the needs of the

client is "choosing or forming a product" (Applicant's claim 1) and Libman

continues that the Virtual Agent module handles a wide variety of classes of

financial products such as life insurance and long term care insurance" (Libman;

col. 9, lines 50-63). Also, on col.9, lines 43-46, Libman discloses, "the Virtual

Agent module uses client information and its own decision logic to select the plan

or plans and the financial product or products which best meet a specified set of

decision criteria". Libman gives examples of financial products on col. 9, lines 59-

63, and they are "term life insurance, permanent life insurance, combinations of

them, health insurances, disability insurances, long term care insurances".

Examiner considers that it is more likely that one would like to buy two separate,

but related insurance policies rather than buying two same type of policies.

D. In response to Applicant's forth argument on page 10, Examiner respectfully submits that in the first office action, Examiner applied 35 U.S.C. 103 and combine the Libman and Gamble references to overcome the limitation of "disproportionately allocating expenses, benefits and obligations regarding said policies among said at least two separate but related policies formed from said life insurance product and said long-term care product" and Gamble reference teaches this limitation on col. 10, lines 21-46 as explained in the previous office action (page numbers 3-4). Libman reference teaches choosing two or more separate but related products, and Gamble reference teaches "the benefit limits varying according to relative severity of patient medical condition" (Gamble; col. 10, lines 21-46) and also on col. 9, lines 46-50, Gamble teaches "computing a second value representing an extent to which the claims cost for the first insurance policy is influenced by the second insurance policy". Therefore the combination of these two references has overcome this limitation.

E. In response to Applicant's fifth argument on page 10, Examiner respectfully submits that Libman discloses "the Virtual Agent module selects the product or products which satisfy the decision making criteria" on col. 12, lines 20-37. Also, on col. 12, lines 54-64, Libman discloses "module processing including the function of determining if the policy appropriately coded". Examiner considers that "determining if the policy is appropriately coded" has the same meaning of "comparing the policies with regulatory requirements".

F. In response to Applicant's sixth argument, Examiner respectfully submits that

claim 1 discloses "determining ownership, beneficiary and premium obligors of

said at least two separate but related policies" and Libman reference discloses

this limitation col. 10, line 55 to col. 11, line 6 and col. 12, lines 20-37. The

limitation of "two separate but related policies" is described above in section (D).

It is noted that the features upon which applicant relies (i.e., favoring one owner

over another in order to achieve a "perk" for a favored executive/employee) are

not recited in the rejected claim(s). Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claims

15 and 16 do not cover this limitation either.

G. In response to applicant's seventh argument about the references fail to show

certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., restructuring of the one owner is benefited at the expense of

another owner) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not

read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057

(Fed. Cir. 1993).

H. In response to Applicant's eighth argument on pages 12 to 13, relating with

Gamble does not teach "two separate but related insurance policies from said life

insurance product and said long term care product", Examiner submits that

Gamble teaches insurance policies of life, accident, disability, health and

combination thereof (col. 9, lines 20-44). Gamble also teaches calculating reduction (saving) in a claims cost of the first insurance policy, or by utilizing an appropriate computational filter to add additional benefits and/or increase the profitability of the insurer's policy (col. 7, lines 41-49). Examiner considers that calculating the cost of the insurance policies has the same meaning of altering policies according to the customer.

I.   In response to Applicant's ninth argument on page 13, about Gamble does not teach "disproportionately allocate expenses, benefits and obligations regarding said policies among at least two separate but related policies", Examiner respectfully submits that the Gamble reference teaches "the benefits limits varying according to relative severity of patient medical conditions" on col. 10, lines 21-40. Examiner considers that this limitation has the same meaning of the same limitation of the 1st claim's portion mentioned above. Also, Examiner would like to emphases that the combination of references Libman and Gamble teach the limitation of the claim as a whole.

J.   In response to Applicant's tenth argument on page 13, about Gamble does not teach "at least two separate but related policies with said regulatory requirements", Examiner respectfully submits that on col. 12, lines 54-64, Libman discloses "module processing including the function of determining if the policy appropriately coded". Examiner considers that "determining if the policy is appropriately coded" has the same meaning of "comparing the policies with regulatory requirements".

K. In response to Applicant's eleventh argument on page 13, about Gamble does not teach "ownership, beneficiary and premium obligators of said at least two separate but related policies because the owner of the concurrent policies is the customer and there is no second premium payer to be favored or disfavored", Examiner respectfully submits that none of the claims disclose "second premium payer to be favored or disfavored". Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

L. In response to Applicant's twelfth argument on page 13, about Libman does not teach "collecting regulatory requirements" is cited in the previous Office Action, and with the broadest interpretation, "legal issues, all local, state and federal laws regarding insurance sales, for example, and additional constraints imposed by product providers may be considered" has the same meaning as collecting regulatory requirements and none of the claims disclose Internal Revenue Codes, section 7702. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

M. In response to Applicant's thirteenth argument on page 14, about Libman does not teach "forming in a data processing apparatus at least two separate but related insurance policies", Examiner submits that Libman teaches "the plan or plans and the financial product or products which best meet a specific set of decision criteria... and applying the decision criteria to select among those plans

and products the ones most suitable for the client based on the decision making criteria", and on col. 11, lines 7-28, Libman gives an example of the Virtual Agent retrieves the information depicted graphically in Figures 6-8; Examiner consider that, Libman teaches forming a policy for the client according to the client's personal information and issue constraints on col. 11, lines 7-28.

N. In response to Applicant's fourteenth argument on page 15, about Libman does not teach "comparing newly formulated policies with regulatory requirements", Examiner respectfully submits that Libman teaches the Virtual Agent module may take into consideration factors such as the underwriting requirements, or legal issues, all local, state and federal laws. Libman teaches on col. 12, lines 54-64 that "In Step I of Virtual Agent.TM. module processing according to this embodiment and method, the module analyzes the past or current performance on a real-time basis of various sale programs. It identifies on a real-time basis who is buying on any geographic or any demographic basis. This step involves determining what the individual client is most likely to buy, making the end users aware of that fact, <u>recommending changes</u>, and if given permission, or <u>if appropriately coded</u>, <u>automatically implementing the changes</u>, which may occur even during the running of the module." As explained in section (B), Examiner considers that "determining if the policy is appropriately coded" has the same meaning of "comparing the policies with regulatory requirements".

O. In response to Applicant's fifteenth argument on page 15, about Libman does not teach "determining ownership, beneficiary and premium obligors of said at

least two separate but related policies", Examiner submits that Libman teaches

client record includes information of name, age, gender of each borrower and co-

borrower. (col. 10, lines 58-62), and continues on col. 11, lines 1-6 to teach

example scenarios. Therefore Examiner interprets that the combination of

Libman and Gamble references teach "determining ownership, beneficiary and

premium obligors of said at least two separate but related policies".

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

7.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-

272-8295. The examiner can normally be reached on 8-4:30.

9.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

10.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DBC
Art Unit 3626
07/18/2006

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